



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/066,230

01/31/2002

Paul Finster

GIST-001/00US

2756

22903

7590

08/16/2006

COOLEY GODWARD LLP
ATTN: PATENT GROUP
THE BOWEN BUILDING
875 15TH STREET, N.W. SUITE 800
WASHINGTON, DC 20005-2221

EXAMINER

SHANG, ANNAN Q

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/066,230 | FINSTER ET AL. | |
| | Examiner | Art Unit | |
| | Annan Q. Shang | 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/02;7/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6-7 and 10-24 are rejected under 35 U.S.C. 102(b) as being anticipated by **Alexander et al (6,177,931)**.

As to claims 1-2, note the **Alexander** reference figures 1 and 3-9 discloses systems and methods for displaying and recording control interface with TV programs, video ads information and EPG information and further discloses a method for operating a set top box (STB or Information Cable Box 'ICB' 24, fig.1 and col.3, lines 1-25), the method comprising:

Providing a plurality of electronic program guide (EPG) preferences to an EPG provider (Head end 'HE' or EPG Web Server, col.5, line 54-67, col.6, lines 12-28, line 56-col.7, line 30, line 46-56, col.8, line 36-64 and col.29, lines 14-39):

Receiving at the STB an EPG application program, where the EPG application is configured according to at least one of the plurality of EPG preferences provided to the EPG provider, a processor (e.g., M-68000) and memory device (RAM) connected to the processor, the memory device for storing the EPG application program in a memory

Art Unit: 2623

associated with the STB (figs.1, 3-9, col.2, line 62-col.3, line 35, col.5, lines 5-49 and col.8, lines 18-35);

Receiving at the STB programming information data structure, where the programming information data structure includes program listing information and where the programming information data structure is configured according to at least one of the plurality of EPG preferences; and rendering at least a portion of the program listing information (favorite channels, Theme guides, Channel guide, etc.,) using the EPG application program (col.2, line 62-col.3, line 35, col.5, lines 56-67, col.6, line 56-col.7, line 56, col.8, lines 18-64, col.9, line 65-col.10, line 60, col.28, line 12-col.30, line 1+), note that the EPG provides collects users profile, using the users interaction to the EPG/websites or by learning analysis, and furthermore uses the ICB-24 or STB unique identifier, determines a characteristic for the ICB-124 and uses these generated information to customizes various part of the EPG based on the preferences.

As to claim 3, Alexander further discloses providing a STB characteristic to the EPG provider, where the received EPG application program is customized according to the provided STB characteristic (col.28, lines 10-29, col.29, line 56-col.30, line 58).

As to claim 6, Alexander further discloses where rendering at least a portion of the listing information comprises, extracting a template from the programming information data structure, and populating the template with at least a portion of the listing information (col.30, line 45-col.32, line 22).

As to claim 7, Alexander further discloses where providing a plurality of preferences comprises: extracting a contact address from the memory local to the STB,

where the contact address is associated with an EPG provider and providing the unique identifier to the contact address (col.8, lines 37-64,col.18, lines 1-67 and col.34, lines 10-55).

As to claim 10, Alexander further discloses where the programming information data structure comprises freshness information, the method further comprising, determining whether the freshness information indicates that additional listing information should be retrieved from the EPG provider (col.8, lines 37-64,col.18, lines 1-67 and col.34, lines 10-55).

As to claim 11, the claimed "A set top box (STB)..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

As to claim 12, the claimed "An electronic programming guide (EPG) system comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

As to claim 13, the claimed "A method for dynamically generating a customized electronic program guide (EPG) program, the method comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 15 is met as previously discussed with respect to claim 1.

As to claim 16, Alexander further discloses where the plurality of EPG program modules comprises a parental control module (col.9, line 65-col.10, line 12 and col.17, lines 13-37).

As to claims 17-18, Alexander further discloses where the plurality of EPG program modules comprises a frame viewing module and instructions to cause a

Art Unit: 2623

browser in the STB to display frames (figs.6-10, col.17, line 50-col.18, line 67 and col.30, line 45-col.32, line 1+).

As to claim 19, the claimed "A method for dynamically generating a customized electronic program guide (EPG) program, the method comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

As to claim 20, **Alexander** reference figures 1 and 3-9 further discloses a method for generating a customized program listing for a set top box (STB), the method comprising:

Receiving from an STB (Head end 'HE' or EPG Web Server) a user preference for operating an electronic program guide (EPG), retrieving programming information; Sorting the retrieved programming information according to the user preference (col.7, lines 6-17, col.8, line 52-64, col.28, line 12-29, col.29, line 12-col.31, line 8);

Formatting the sorted program information according to the user preference, and providing the formatted program information to the STB (col.19, line 13-45 and col.30, line 46-col.31, line 41).

Claims 21-22 are met as previously discussed with respect to claim 6.

As to claims 23-24, **Alexander** further discloses where the formatting comprises arranging sorted program information into an interpreted-language data structure and where the sorting comprises generating a plurality of lists of program information, where at least one of the plurality of lists corresponds to the user preference (col.30, line 46-col.31, line 41, line 66-col.34, line 55)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alexander et al (6,177,931)** as applied to claims 1 and 3 above, and further in view of **Watson et al (2004/0049574)**.

As to claims 4-5, Alexander teaches an EPG Web service provider or Headend EPG provider which receives STB characteristics information, e.g. STB identifier, etc., but fails to explicitly teach where the STB characteristic comprises, STB memory information and STB manufacturer identifier.

However, note the **Watson** reference figures 1-6, discloses a Web Server which responds to request message from a remote user device (PDA, PC, WAP Phone, TV, etc.,) and dynamically generates a menu based on extracted information or cookie, e.g., memory capacity, manufacturer identifier, etc., receive from the device (fig.5, page 2, [0046], [0051-53], page 5, [0074-0077], [0086-0092] and [0130-0131]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Watson into the system of Alexander efficiently customizes EPG or menu to the various user devices based on their capabilities.

As to claims 8-9, Alexander teaches using a browser application, but fails to explicitly teach where the EPG application comprises JavaScript code and where the programming information data structure comprises a JavaScript data structure.

However, Watson further teaches Java application and generating a menu using JavaScript (page 2, [0047-0048] and [0068-0070]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Watson into the system of Alexander to run a secure and platform-neutral application that is more robust and manages memory on its own.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Klopfenstein et al. (6,985,190), disclose real-time signal strength display of terrestrial digital TV signals.

Hind et al. (6,715,129), disclose achieving application-specific document content by transcoding using Java server pages.

Abato et al. (6,513,069), disclose enhanced video programming system and method for providing a distributed community network.

Li et al. (6,345,279), disclose methods and apparatus for adapting multimedia content for client devices.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', written over a rectangular box.

Annan Q. Shang